

REMARKS

Claims 1-4, 7, 9, 10, 12-14, 17, 19-23, 26, and 28 are pending in this application.

DOUBLE PATENTING REJECTION

In the Office Action, all pending claims in this application were rejected as being unpatentable on the ground of obviousness-type double patenting in view of the claims in U.S. Patent No. 6,695,830 (Virgil et al.). In response, Applicants submit the enclosed terminal disclaimer. The filing of this terminal disclaimer obviates the double patenting rejection and is not an admission of the propriety of that rejection. *See* MPEP § 804.02.

REJECTIONS UNDER § 102

In the Office Action, claims 1, 2, 4, 10, 12, 14, 20, 21, and 23 were rejected as being anticipated under § 102(b) by U.S. Patent No. 5,306,250 (March et al.). Applicants respectfully request reconsideration of this rejection and submit the following remarks.

Independent claims 1, 10, and 20 recite “dispensers consisting only of dispensers positioned in a single plane oriented substantially perpendicular to said axis.” An example of this configuration is demonstrated in the embodiment shown in FIG. 2 of the present application, where the dispensers 20 are all positioned only in a single plane 19.

March describes several drug delivery catheter assemblies having microapertures 48 which “provide the channels of fluid communication between the interior of membrane 46 and lesion 28.” None of the catheter assemblies in *March* are shown to have the microapertures positioned only in a single plane, which is a configuration required by claims 1, 10, and 20. For at least these reasons, Applicants respectfully submit that claims 1, 2, 4, 10, 12, 14, 20, 21, and 23 are not anticipated by *March* and request allowance of these claims.

REJECTIONS UNDER § 103**A. March in View of Wilcox**

In the Office Action, claims 3, 13, and 22 were rejected as being rendered obvious by

March in view of U.S. Patent No. 5,681,289 (Wilcox et al.). Applicants respectfully request reconsideration of this rejection and submit the following remarks.

Claims 3, 13, and 22 specifies that the “fluid medicament comprises a radioactive isotope.” Independent claims 1, 10, and 20, from which these claims respectively depend, each recite the step of “releasing said fluid medicament through said dispensers.”

1. The Use of Radioactive Isotopes is an Isolated Teaching in Wilcox and Not Associated With Any Medical Devices

To establish a *prima facie* case of obviousness, there must be a teaching, suggestion, or motivation to modify the reference or to combine reference teachings. See MPEP § 2142. The prior art does not provide the proper teaching, suggestion, or motivation to modify *March* according to the teachings of *Wilcox* relating to radioactive isotopes.

The Office Action states that the teachings of *Wilcox* are demonstrative of radioactive isotope use being “old in the medical delivery devices art,” and therefore, that it would be obvious to use radioactive isotopes in the drug delivery devices of *March*. (Office Action 11/02/2006 at page 4, paragraph 8). However, Applicants respectfully submit that this is not the teaching of *Wilcox*. The use of radioactive isotopes is an isolated teaching merely serving as background information relating to surgical procedures in general. (*see* col. 1, lns. 11-15). Nowhere does *Wilcox* mention the use of radioactive isotopes in association with any of the medical devices described therein.

In fact, *Wilcox* pertains only to devices that are used for the delivery of chemical agents: a “chemical dispensing system for dispensing a liquid chemical agent, such as an antibiotic, anesthetic, growth factor, hormone, anti-neoplastic agent, or the like . . .” (*see* Abstract); “It is a principal object of the present invention in a chemical dispensing system to provide a sump or bladder that is linked by a tube or other conduit to a reservoir to be implanted at or closely proximate to a site of a surgical procedure for dispensing a chemical agent through the sump or bladder to that site.” (*see* Summary at col. 1, lns. 65-67); “The present invention provides a system of various configurations of a sump or bladder that is shaped to fit between a prosthesis and bone surface or is to be positioned adjacent to a bone or trauma site that is involved in a

surgical procedure. Thereat, the individual sump or bladder is then used to dispense an antibiotic or like chemical agent through holes or pores formed therein.” (see Detailed Description at col. 5, lns. 25-31).

Therefore, because the chemical dispensing system of *Wilcox* is not associated with the use radioactive isotopes, there is no suggestion to modify the delivery device of *March* to deliver radioactive isotopes. Without a proper teaching, suggestion, or motivation to modify the delivery device of *March* in this manner, a *prima facie* case of obviousness cannot be made. For at least these reasons, Applicants submit that claims 3, 13, and 22 are patentable over *March* and *Wilcox*, and request allowance of these claims.

2. The Combination of *March* and *Wilcox* Does Not Include All Required Elements

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. Even if *March* and *Wilcox* could be properly combined, the combination would not include all the required elements in claims 3, 13, and 22, which recite “dispensers consisting only of dispensers positioned in a single plane oriented substantially perpendicular to said axis.” This feature is not found in either *March* or *Wilcox*, and therefore, cannot be found in their combination.

For at least these reasons, Applicants respectfully submit that claims 3, 13, and 22 are patentable over *March* and *Wilcox*, and request allowance of these claims.

B. *March* in View of *Nabel*

In the Office Action, claims 7, 9, 17, 19, 26, and 28 were rejected as being rendered obvious by *March* in view of U.S. Patent No. 5,328,470 (Nabel et al.). Applicants respectfully request reconsideration of this rejection and submit the following remarks.

By virtue of their dependency on their respective independent claims, claims 7, 9, 17, 19, 26, and 28 recite “dispensers consisting only of dispensers positioned in a single plane oriented substantially perpendicular to said axis.” To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See MPEP §

2143.03.

Without conceding that it would be proper to combine *March* and *Nabel*, such a combination would not include all the required elements in claims 7, 9, 17, 19, 26, and 28, which recite "dispensers consisting only of dispensers positioned in a single plane oriented substantially perpendicular to said axis." This feature is not found in either *March* or *Nabel*, and therefore, cannot be found in their combination.

For at least these reasons, Applicants respectfully submit that claims 7, 9, 17, 19, 26, and 28 are patentable over *March* and *Nabel*, and request allowance of these claims.

CONCLUSION

Applicants respectfully submit that the present application is in condition for allowance. The Examiner is invited to contact Applicants' representative to discuss any issue that would expedite allowance of this application.

The Commissioner is authorized to charge all required fees, fees under § 1.17, or all required extension of time fees, or to credit any overpayment to Deposit Account No. 11-0600 (Kenyon & Kenyon LLP).

Respectfully submitted,

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